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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,856	11/24/2003	Timothy Roberts	920476-95165	5181
23644 7590 11/27/2009 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER AKINTOLA, OLABODE				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 11/27/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary**Application No.**

10/720,856

Applicant(s)

ROBERTS, TIMOTHY

Examiner

OLABODE AKINTOLA

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9, 11-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (USPN 5819092), hereinafter Ferguson.

Re claims 1, 11 and 17: Ferguson teaches a method of billing a communication network user for the purchase of goods or services associated with the transport of packet from the communication network into a packet communication network, each packet having an address which identifies a provider of goods or services, wherein the method is executed by a server and comprises: accessing, by the server, a set of rules (col. 29, lines 35-44 “*specify the fees that will*

be levied on or paid to users"); determining, by the server, from said rules and each packet address, a respective billing tariff and a network user account to be debited for the transport of that packet (col. 30, lines 20-58, "*Levying Fees on Users*"); obtaining, by the server, a coupon from an account database, representing an amount of credit (col. 31, lines 60 through col. 32, line 4, col. 18, lines 30-39); and debiting, by the server, a network user account by the amount of that credit, and allowing the transport of packet traffic for that network user (abstract, col. 8, lines 55 through col. 9, line 20, "*A transaction can debit a user's account*").

Ferguson does not explicitly teach that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include this feature for the obvious reason of guaranteeing that service provider receives payment before providing such goods or services.

Re claim 2: Ferguson teaches wherein account details for network users and account details of providers of goods and services are stored in a common accounts database (col. 8, lines 55 through col. 9, line 20).

Re claim 3: Ferguson teaches wherein transfers of credit between accounts stored in the accounts database are determined from coupons generated for each transaction (col. 31, lines 60 through col. 32, line 4)

Re claims 4, 5, 12, 13, 18 and 19: Ferguson teaches wherein network users have postpaid account (col. 8, lines 55 through col. 9, line 20, col. 29, lines 35-44). Ferguson does not explicitly teach wherein network users have prepaid accounts; wherein each user account is accorded a respective credit limit. Official notice is hereby taken that the concept of using a prepaid or postpaid accounts for transaction wherein the user account is accorded a credit limit is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include this feature for the obvious reason of providing alternative forms of payment to the user, thereby enhancing the flexibility of the system.

Re claim 6: Ferguson teaches wherein user validation is performed prior to completion of a transaction (abstract, col. 3, lines 62-65, col. 10, lines 1-10).

Re claims 7, 15, 16 and 20: Ferguson does not explicitly teach wherein the network is a wireless network. Official notice s hereby taken that the use of wireless network is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include this feature for the obvious reason of providing wireless alternative to the user, thereby enhancing the flexibility of the system.

Re claim 8: Ferguson teaches a method executed on a server configured to facilitate on line shopping, the method comprising: debiting, by the server, the cost of goods or services

purchased by a customer to that customer's (postpaid) account with a network operator (abstract, col. 8, lines 55 through col. 9, line 20, "*A transaction can debit a user's account*"); applying, by the server, a corresponding credit to an account held by a provider of those goods or services(abstract, col. 8, lines 55 through col. 9, line 20, "*A transaction can debit a user's account*", col. 29, lines 52-55); obtaining, by the server, a coupon from an account database, representing an amount of credit (col. 31, lines 60 through col. 32, line 4, col. 18, lines 30-39); and debiting, by the server, a network user account by the amount of that credit, and allowing the transport of packet traffic for that network user (abstract, col. 8, lines 55 through col. 9, line 20, "*A transaction can debit a user's account*").

Ferguson does not explicitly teach prepaid or postpaid account; and that the debiting of the network user is done before allowing the transport of the packet traffic for the network user. Official notice is hereby taken that the use of prepaid or postpaid account and concept of debiting a user account before providing a good or service (in this case transporting packet traffic for the network user) are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ferguson to include these features for the obvious reason of providing alternative forms of payment to the user and guaranteeing that service provider receives payment before providing such goods or services.

Re claim 9: Ferguson teaches wherein a transaction charge is retained by the network operator (abstract, col. 8, lines 55 through col. 9, line 20, "*A transaction can debit a user's account*").

Re claims 10 and 14: Ferguson teaches wherein a supplier of goods and services is credited with a portion of the network operator's revenue for the transport of the packet traffic relating to a transaction (abstract, col. 4, lines 64-67, col. 8, lines 55 through col. 9, line 20, "*A transaction can debit a user's account*").

Response to Arguments

Applicant's arguments filed 9/9/2009 have been fully considered but they are not persuasive.

Applicant argues that Fergusson fails to teach "determining from said rules and each packet address, a respective billing tariff and a network user account to be debit". Examiner respectfully disagrees. Fergusson explicitly teaches various examples of fees that can be levied against the user's account (col. 30, lines 20-58) under different scenarios.

Applicant also argues that Fergusson fails to teach "obtaining a coupon from an account database, representing an amount of credit". Examiner respectfully disagrees. Examiner broadly interprets the term "coupon" as quote or amount to be charged (see Applicant's specification on page 10, lines 21-22). Fergusson explicitly teaches a "coupon" (see col. 31, lines 60 through col. 32, line 4, col. 18, lines 30-39). Examiner notes the description of "coupon" as explained in Applicant's remarks filed on 9/9/2009 on page 12 is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner also notes that Applicant's description of coupon as "charging of different rate depending on the contact (i.e., is the user simply browsing a website or downloading music),

crediting of the provider (e.g., the provider is credited for download but not browsing)" (see Applicant's remarks on page 12, lines 2-4) is taught by Fergusson (col. 30, lines 52-59).

Regarding claim 17, examiner notes that the corresponding structure for both "packet analyzer" or "means for obtaining a coupon" is a server (compare to claim 1). Fergusson explicitly teaches said server.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/
Examiner, Art Unit 3691